

1 Gordon Andrew Petersen, II (SBN: 279587)
2 LAW OFFICE OF DREW PETERSEN, P.C.
3 17581 Irvine Boulevard, Suite 108
4 Tustin, California 92780
5 Telephone: (714) 569-0043
6 Facsimile: (714) 569-0289
7 Email: drew@dpetersenlegal.com

8 Brian P. Kinder (SBN: 212332)
9 THE KINDER LAW GROUP, APC
10 19200 Von Karman Avenue, Fourth Floor
11 Irvine, California 92612
12 Telephone: (949) 216-3070
13 Facsimile: (949) 216-3074
14 Email: bkinder@tklglaw.com

15 Attorneys for Plaintiffs

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17
18 **UNITED STATES DISTRICT COURT**
19 **CENTRAL DISTRICT OF CALIFORNIA**
20

21 **MIGUEL SOLORIO, and**
22 **THESHOWLORIOS INC.**
23 Plaintiffs,

24 v.

25 **CARECO, LLC, JEFF MARTIN,**
26 **TERRY ROBERTS, PAUL**
27 **STROMBERG and DOES 1 to 20,**
inclusive,
Defendants.

Case No.: 8:24-cv-00663 JVS (JDEx)
Judge: Hon. James V. Selna

**PLAINTIFFS' NOTICE OF
MOTION AND MOTION TO
DISQUALIFY DEFENDANTS'
COUNSEL AND LAW FIRM**

Hearing Date: June 24, 2024
Time: 1:30 PM
Dept.: 10C

TO THE CLERK OF THE COURT, ALL PARTIES, AND THEIR
ATTORNEYS OF RECORD:

PLEASE TAKE NOTICE that on June 24, 2024, at 1:30 PM, or as soon
thereafter as the parties may be heard, in Department 10C of the above captioned

1 Court located at 411 W. Fourth Street, Santa Ana, California 92701, Plaintiffs
2 Miguel Solorio and TheShowlorios Inc., will and do hereby move for an Order
3 disqualifying Defendants' Attorney, Caroline Mankey, and the law firm of
4 Ackerman LLP from representing Defendants, and each of them, in this matter.

5 This motion is made upon the grounds there is an actual and direct conflict
6 of interest between the parties, that Defendants counsel represented Miguel Solorio
7 and Defendants prior to this litigation, and the subject matter of the representation
8 was substantially related to the pending litigation, requiring disqualification.

9 This motion is based upon this notice of motion, the accompanying
10 memorandum of points and authorities, the Declaration of Brian Kinder, the
11 Declaration of Miguel Solorio, all records in the Court's file, and such other
12 documentary and oral evidence which may be presented at the hearing of this
13 matter.

14 This motion is made following the conference of counsel pursuant to L.R. 7-
15 3 which took place on May 8, 2024.

16 LAW OFFICE OF DREW PETERSEN, P.C.

17 Dated May 24, 2024

18 /s/ _____
19 Gordon Andrew Petersen, II
20 Attorney for Defendant,
21 Miguel Solorio

22 THE KINDER LAW GROUP, APC

23 Dated May 24, 2024

24 /s/ _____
25 Brian Kinder
26 Attorney for Defendant,
27 Miguel Solorio

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MEMORANDUM OF POINTS AND AUTHORITIES

I. Procedural History

Plaintiffs commenced this legal action against Defendants on March 27, 2024, alleging trademark infringement, breach of contract, and various business torts. In response, Defendants filed a Motion to Dismiss Case, scheduled to be heard on June 10, 2024.

The facts and circumstances in this case are related to those in *CareCo, LLC v. Solorio*, 5:24-cv-00836-JVS (JDEx), which Solorio removed to federal court based on federal question jurisdiction involving trademarks on April 19, 2024. Solorio also filed a Notice of Related Cases.

On May 8, 2024, counsel for both parties met and conferred regarding the filing of this motion, and no resolution was reached.

Solorio now brings this motion to disqualify Plaintiff's counsel, Caroline Mankey, and the firm Ackerman LLP, from representing Plaintiff CareCo, in this matter and the related case.

II. Statement of Facts



Following termination of a June 3, 2022, agreement ("the 6/3/22 Agreement"), Solorio and CareCo are embarking on litigation in related cases involving claims of trademark infringement, among others. The trademarks at issue in the disputes include, among others, SHOE DOC™, FOAMZONE 150™, and FZ150™. CareCo asserts that Plaintiff Solorio was not using the SHOE DOC™ trademark in connection with the sale of shoe cleaning products prior to the date when the parties entered into the 6/3/22 Agreement. Plaintiff Solorio contests that allegation and asserts that sold shoe cleaning products under the SHOE DOC™ trademark long before the 6/3/22 Agreement – with the underlying product name being called SPECIAL CREAM™ as pictured below.



Plaintiff Solorio sold the SPECIAL CREAM™ product under the SHOE DOC™ brand for well over a year and half when Defendant Solorio decided to add a new line of products under the SHOE DOC™ brand. Before meeting Defendant CareCo, Plaintiff Solorio came up with the name for the new line, FOAMZONE 150™ and even created the FZ150™ logo shown below. Plaintiff Solorio then began test-marketing the products, but sales were far greater than Plaintiff Solorio expected...so Plaintiff Solorio decided to seek assistance – which is when he approached Defendant CareCo.



Prior to termination of the 6/3/22 Agreement and the commencement of this litigation, Akerman, LLP and specifically lead counsel Caroline H. Mankey, Esq. (“Ms. Mankey”), represented Plaintiff Solorio, Defendant CareCo, and an employee of CareCo, Defendant Paul Stromberg, in respect to numerous trademark applications before the U.S. Patent and Trademark Office (“USPTO”):”) as follows:

<u>MARK</u>	<u>SERIAL NO.</u>	<u>FILING DATE</u>	<u>APPLICANT</u>
	97192410	Dec. 28, 2021	Miguel Solorio
SHOE DOC	97440597	June 2, 2022	Paul Stromberg
FZ150	98033769	June 8, 2023	CareCo, LLC
	98056947	June 8, 2023	CareCo, LLC

A. Stromberg Application.

Unbeknownst to Solorio at the time, Defendant Stromberg filed an application with the USPTO (Serial No. 97440597) on June 2, 2022, (i.e., the day before the parties entered into the 6/3/22 Agreement) wherein Defendant Stromberg sought to register the SHOE DOC™ mark in his name personally for the following goods: “cleaner for use on shoes, purses, upholstery, fabrics.” *See* Kinder Decl., **Ex. 1** (“the ‘597 Application”). On March 24, 2023, the USPTO assigned the ‘597 Application to an Examining Attorney who, after reviewing the application, raised various problems with the application and recommended Mr. Stromberg retain the services of a trademark attorney. *Id.* at **Ex. 2** (Office Action). On May 12, 2023, Ms. Caroline Mankey entered her appearance in the ‘597 Application when she filed a “Change Address or Representation Form.” *Id.* at **Ex. 3** (Representation Form). When Mankey prepared and filed the above-referenced Representation Form, she did not identify Mr. Stromberg as the signatory; she identified and had the form signed by Mr. Miguel Solorio. *Ibid.* In doing so, Ms. Mankey appointed herself together with the following other attorneys of the Akerman LLP firm: “Mark D. Passler; Peter A. Chiabotti; Ryan L. Harding; Brice S. Dumais; J. Andre Cortes; Victoria J. B. Doyle; Kourtney A. Mulcahy.” Thereafter, on June 22, 2023, Ms. Mankey prepared and filed a response to the Examining Attorney wherein she included the following declaration (*Id.* at **Ex. 4**

(Response to Office Action):

“The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that, if the applicant submitted the application or allegation of use (AOU) unsigned, all statements in the application or AOU and this submission based on the signatory's own knowledge are true, and all statements in the application or AOU and this submission made on information and belief are believed to be true.”

Following that declaration, Ms. Mankey made the following representations to the USPTO:

The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 09/07/2020 and first used in commerce at least as early as 05/01/2022, and is now in use in such commerce. Applicant hereby submits one(or more) specimen(s) for Class 003. The specimen(s) submitted consists of photos of mark on products.



B. Solorio Application.

The same day Ms. Mankey and Ackerman LLP assumed representation on the ‘597 Application (i.e., May 12, 2023), they also began representing Mr. Solorio

1 personally in his pending application, Serial No. 97192410 (“the ‘410 Application)
 2 for the DOC™ mark in a stylized form. Mr. Solorio personally filed the ‘410
 3 Application with the USPTO in Dec. 2021 which inadvertently lapsed. *Id.* at **Ex. 5**
 4 (Representation Form). After becoming Mr. Solorio’s counsel and reinstating the
 5 ‘410 Application, Ms. Mankey prepared, signed and filed an Amendment to Allege
 6 Use on behalf of Mr. Solorio on June 7, 2023. *Id.*, **Ex. 6** (Allegation of Use). In the
 7 Amendment, Ms. Mankey personally attested to the same dates of first use set forth
 8 ‘597 Application. *Id.* (i.e., attesting to first use as early as 09/07/2020 (anywhere)
 9 and 05/01/2022 (interstate commerce)).

10 C. **CareCo Applications.**

11 On June 8, 2023, Ms. Mankey filed two applications with the USPTO
 12 seeking to register the FZ150™ mark in both standard characters (Serial No.
 13 98033769) and stylized logo (Serial No. 98056947) formats. *Id.*, **Ex. 7-8**,
 14 respectively. Mankey filed those applications in the name of Defendant CareCo
 15 alone and attested to use of the FZ150™ marks in connection with the following
 16 goods: “shoe cleaners and shoe conditioners.” *Ibid.* Therein, Ms. Mankey stated,
 17 “the mark was first used by the applicant or the applicant's related company or
 18 licensee or predecessor in interest at least as early as 05/00/2022, and first used in
 19 commerce at least as early as 05/00/2022, and is now in use in such commerce.”
 20 *Id.* Notably, Ms. Mankey personally signed the applications and included the
 21 following statements:

- 22 • The signatory believes that the applicant is the owner of the trademark/service mark sought to be registered;
- 23 • The mark is in use in commerce and was in use in commerce as of the filing date of the application on or in connection with the goods/services in the application;
- 24 • The specimen(s) shows the mark as used on or in connection with the goods/services in the application and was used on or in connection with the goods/services in the application as of the application filing date; and
- 25 • To the best of the signatory's knowledge and belief, the facts recited in the application are accurate.
- 26 • The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. §
- 27

1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

D. False Representations of Defendants' Counsel in This Matter

In a declaration filed in support of Defendants' Motion to Dismiss Case filed in this matter, Mankey submitted a sworn declaration to this Court containing statements completely contradicting the multiple prior sworn statements made to the USPTO. Specifically, Ms. Mankey's Motion to Dismiss and her supporting declaration assert Solorio did not use the SHOE DOCTM or DOCTM trademark prior to the 6/3/22 Agreement; whereas, Ms. Mankey's *multiple* prior declarations attest under oath to use of the SHOE DOCTM and DOCTM marks by Solorio as early as 9/7/20 as well as use of the FZ150TM mark as early as 05/00/2022. Ms. Mankey's filed declaration and the motion show CareCo and its affiliates intend to argue the declarations Ms. Mankey filed with the USPTO on behalf of Solorio (and the others filed on behalf of CareCo, and its employee) were false and included erroneous dates of use (Dkt. 20-1, p. 2-3):

"As discussed in the accompanying motion, it is CareCo's position that its use of an erroneous date of first use in commerce in support of applications to register the FZ150 and SHOE DOC trademarks does not confer on Solorio any trademark rights that had not accrued before the parties' actual first use of the marks in commerce. "[A]n erroneous date of first use is immaterial because it 'could not possibly result in the allowance of a registration which would otherwise not be allowed, as long as there was technical trademark use prior to the filing of the application.'" 2 McCarthy on Trademarks and Unfair Competition § 31.74 (5th ed. 2024) (quoting *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 U.S.P.Q. 73, 1983 WL 51834 (T.T.A.B. 1983)). Consequently, any misstatement of the date of first use in commerce by CareCo in trademark applications does not defeat CareCo's joint ownership of the trademarks based on the parties' actual collective and contemporaneous use in commerce.

I declare under penalty of perjury pursuant to the laws of the State of California and the United States of America that the foregoing is true and correct."

Plaintiffs assert the foregoing creates an unacceptable conflict in Ackerman

1 LLP and Ms. Mankey's continued representation of Defendants. The
 2 California Rules of Professional Conduct do not allow an attorney to
 3 represent a client, adverse to a previous client of that same attorney, where
 4 the two representations are "substantially related." There can be no doubt
 5 that Ms. Mankey's former representation of Plaintiff Solorio, as the attorney
 6 with primary responsibility for prosecuting trademark applications directed
 7 to the very marks at issue in this case, is substantially related to the claims
 8 (and prosecution in the related case) of CareCo and the individual
 9 defendants. Under these circumstances California law conclusively
 10 presumes both that Ms. Mankey had access to confidential information of
 11 Plaintiff Solorio and the information will be shared with other attorneys at
 12 her firm. Therefore, the entire Akerman, LLP firm must be disqualified from
 13 any further representation in this litigation.

14 **III. Legal Standard to Disqualify Counsel**

15 Federal Courts in California are required to look to state law to decide
 16 motions to disqualify. *S.E.C. v. King Chuen Tang*, 831 F.Supp.2d, 1130, 1141
 17 (N.D. Cal. 2011); *In re County of Los Angeles*, 223 F.3d 990, 995 (9th Cir. 2000).
 18 In the Central District of California attorneys are required to adhere to the
 19 standards of professional conduct required of members of the State Bar of
 20 California. Local Rule 83-3.1.2

21 Under California law, the propriety of disqualification depends on the
 22 unique circumstances of the case. *The Oaks Mgmt. Corp v. Sup. Ct.*, 145
 23 Cal.App.4th 453, 464-65 (2006). During a motion to disqualify, the court is
 24 required weigh the competing interests of a party's right to counsel of choice and
 25 the financial burden of replacing disqualified counsel against the fundamental
 26 principal of fair resolution of disputes requires vigorous representation by
 27 independent counsel unencumbered by conflicts of interest. *William H. Raley Co.*

1 v. *Sup. Ct.* 149 Cal.App.3rd 1042, 1048 (1983). However, the paramount concern
 2 is the preservation of public trust in the scrupulous administration of justice and the
 3 integrity of the bar. *People v. Speedee Oil Change Systems, Inc.*, 20 Cal.4th 1135,
 4 1145 (1999).

5 A party may move to disqualify an opposing party's counsel on grounds
 6 recognized by law, including mandatory disqualification for a conflict of interest
 7 based on a prior or current representation. *Lynn v. George*, 15 Cal.App.5th 630,
 8 637 (2017). The right to disqualify counsel is within the discretion of the trial
 9 court's exercise of inherent powers. *Visa U.S.A., Inc. v. First Data Corp.*, 241
 10 F.Supp.2d 1100, 1103 (N.D. Cal. 2003); *In re Complex Asbestos Litig.*, 232
 11 Cal.App.3rd 572, 575 (1991); Cal. Code Civ. Proc. §128, subd. (a)(5). However,
 12 such motions are disfavored due to their potential for abuse and are subject to strict
 13 judicial scrutiny. *Optyl Eyeware Fashion Intern. Corp. v. Style Companies, Ltd.*,
 14 760 F.2d 1045, 1050 (9th Cir. 1985).

15 **IV. Ms. Mankey and Ackerman LLP's Representation of Defendants**
 16 **Substantially Relates to Their Personal Representation of Solorio in His Prior**
 17 **Trademark Application.**

18 In successive representation cases, where the lawyer's duty of
 19 confidentiality is the focus, if the moving party establishes a substantial
 20 relationship exists between the former representation and the current litigation,
 21 there is a conclusive presumption the attorney has obtained confidential
 22 information from the former client, requiring disqualification. *Flatt v. Sup. Ct.*
 23 *(Daniel)* 9 Cal.4th 275, 283; *Fiduciary Trust Int'l of Calif. V. Sup. Ct. (Brown)* 218
 24 Cal.App.4th 465, 481 (2013). A substantial relationship exists between a prior
 25 representation and the current action when evidence supports the rational
 26 conclusion information material to the evaluation, prosecution, settlement, or
 27 accomplishment of the former representation is also material to evaluation,

1 prosecution, settlement, or accomplishment of the current representation. *Sierra v.*
2 *Costco Wholesale Corp.*, 630 F.Supp.3d 1199, 1205 (N.D. Cal, 2022).

3 There is a substantial relationship between the work Ms. Mankey and
4 Ackerman LLP performed on behalf of Solorio, and the litigation in this case, as
5 well as the Complaint filed by CareCo in the related matter. It is undisputed
6 Caroline Mankey and Ackerman LLP assumed and represented Miguel Solorio
7 personally on May 11, 2023, when he signed a Change of Representation,
8 appointing them as his attorney before the USPTO. Kinder Decl. Ex. 5. Thereafter,
9 Ms. Mankey submitted a petition to revive the abandoned application and made
10 alterations and amendments to Solorio’s trademark application as his attorney. *Id.*
11 at Ex. 6. While Mankey and Ackerman were eventually relieved as Solorio’s
12 attorney, the stylized DOC™ trademark application is substantially related to the
13 matters in CareCo’s complaint.

14 Defendants’ Motion to Dismiss filed in this action, specifically attempts to
15 dispute and discounts any right of Solorio to any trademarks before June 3, 2022,
16 when the written agreement was entered into with Defendant CareCo. Dkt. 20 p.8.
17 Furthermore, Ms. Mankey submitted a sworn declaration in this case alleging the
18 dates of first use listed in all the trademark applications above were erroneous and
19 immaterial—contrary to the interests of Solorio and the multiple declarations she
20 previously submitted to the USPTO. Dkt. 20-1, p. 2-3.

21 In the related action (*Careco v. Solorio*), CareCo’s complaint alleges three
22 causes of action: breach of written contract, breach of fiduciary duty, and
23 declaratory relief/judgment. The complaint specifically lists Solorio’s stylized
24 DOC™ trademark application as part of the Shoe Doc Partnership’s trademarks
25 and Shoe Doc Products. Dckt. 1, Ex. 3 ¶ 20(b). The written agreement between
26 CareCo and Solorio, as alleged by CareCo, applies to “[a]ny products derived from
27 the branding of Shoe Doctor.” *Id.* at ¶ 42. CareCo’s request for declaratory

1 judgment also includes a request for a declaration of rights regarding Solorio's
2 obligation not to compete with the Shoe Doc Partnership and Shoe Doc Products,
3 and not to disparage and harm the value of Shoe Doc Partnership's trademarks. *Id.*
4 at ¶ 52-53. Furthermore, the prayer requests an injunction prohibiting Solorio from
5 using any of SHOE DOC (and other) registered and unregistered trademarks. *Id.* at
6 Ex. 3, p.17, ln 23-24.

7 Solorio's stylized DOC™ trademark application comprises part of the
8 trademarks CareCo seeks to bar Solorio from using or otherwise disparaging, and
9 CareCo, claims ownership to it, contrary to Solorio's interest. CareCo's complaint
10 alleges Solorio has no right to use or own the SHOE DOC™ and stylized DOC™
11 trademarks.

12 Mankey and Ackerman LLP represented Solorio personally with regard to
13 both applications seeking protection for these marks in 2023, and now seek to
14 advocate against him and the work they performed on his behalf as his personal
15 attorney. Given the prosecution of the trademark directly relates to the issues in
16 this lawsuit, and the related case by CareCo, there is a substantial relationship
17 between Mankey and Ackerman LLP's prior representation of Solorio and their
18 current representation of Defendants. In comparable circumstances, courts have not
19 hesitated to disqualify the former attorney and their entire firm. *See e.g., Levi*
20 *Strauss & Co. v. Abercrombie & Fitch Trading Co.*, No. C 07-03752 JSW, 2007
21 WL 3203056, at *1 (N.D. Cal. 2007) (disqualifying both the attorney and entire
22 Howrey LLP law firm where the attorney had prosecuted trademark applications
23 on behalf of the two parties to the dispute).

24 Given there is a substantial relationship between the prior representation of
25 Solorio and the representation of Defendants, there is a conclusive presumption
26 confidential information was relayed, and Ms. Mankey and Ackerman LLP must
27 be disqualified from advocating against Solorio in this case.

IV. Ms. Mankey and Ackerman LLP’s Representation of Defendants Violates California’s Rule of Professional Conduct, Rule 1.9, Because The Defendants’ Interest Is Materially Adverse to Solorio, a Former Client.

California Rules of Professional Conduct, Rule 1.9, states in pertinent part,

“(a) A lawyer who has formerly represented a client in a matter shall not thereafter represent another person in the same or a substantially related matter in which that person’s interest are materially adverse... to the former client unless the former client give informed written consent...

“(c) A lawyer who has formerly represented a client in a matter or whose present or former firm has formerly represented a client in a matter shall not thereafter:

“(1) use information protected by Business and Professions Code section 6068, subdivision (e) and rule 1.6 acquired by virtue of the representation of the former client to the disadvantage of the former client except as these rules or the State Bar Act would permit... or

“(2) reveal information protected by Business and Professions Code section 6068, subdivision (e) and rule 1.6 acquired by virtue of the representation of the former client except as these rules or the State Bar Act permit...”

In California, an attorney, even after severing their relationship with a client, may not do anything which will injuriously affect the former client in any matter in which they formerly represented the client, or use any knowledge or information acquired by the previous relationship, in accordance with the rules of professional conduct. *O’Gara Coach Co., LLC v. Ra*, 30 Cal.App.5th 1115, 1124 (2019).

Furthermore, if the attorney personally provided legal advice and services to the former client, it must be presumed confidential information has passed to the attorney and there cannot be and delving into the specifics of the communications between the lawyer and former client to show the attorney did or did not receive

1 confidential information during the relationship. *Jessen v. Hartford Casualty Ins.*
2 *Co.*, 111 Cal.App.4th 698, 709 (2003).

3 In this case, Ms. Mankey and Ackerman LLP are attempting to represent
4 Defendants against their former business partner, Solorio, despite the fact the firm
5 represented all parties previously. Furthermore, no meaningful disclosure was
6 provided to Solorio, and informed written consent was never obtained from him.
7 Solorio Decl. ¶ 10. Defendants' and Solorio's interests are materially adverse, as
8 there are multiple lawsuits pending between them. Furthermore, a significant
9 portion of the dispute involves the trademark application work performed by Ms.
10 Mankey and Ackerman LLP on behalf of all parties relating to the SHOE DOC™
11 and stylized DOC™ trademarks. Permitting Ms. Mankey and Ackerman LLP to
12 continue to represent Defendants will injuriously affect Plaintiff Solorio because
13 they are attempting to dispute the validity of the trademark applications they
14 submitted, prosecuted, and attested to through multiple sworn declarations on
15 Solorio's behalf.

16 There is a direct conflict between Solorio and Defendants, over the
17 trademark work performed by Ms. Mankey and Ackerman LLP. In this case, Ms.
18 Mankey and Ackerman LLP are taking a position materially adverse to a former
19 client, Solorio, in a substantially related matter without informed written consent.
20 California law does not permit this and they must be disqualified from representing
21 Defendants.

22 **V. Ms. Mankey and Ackerman LLP Are Violating California's Rules of**
23 **Professional Conduct Rule 1.7, Prohibiting a Lawyer From Representing a**
24 **Client if the Representation is Directly Adverse to Another Client in the Same**
25 **or a Separate Matter.**

26 California Rules of Professional Conduct, Rule 1.7, states in pertinent part,
27

1 “(a) A lawyer shall not, without informed written consent
2 from each client... represent a client if the representation
3 is directly adverse to another client in the same or a similar
4 matter.

5 “(b) A lawyer shall not, without informed written consent
6 from each affected client... represent a client if there is a
7 significant risk the lawyer’s representation...will be
8 materially limited by the lawyer’s responsibilities to or
9 relationships with another client, a former client...”

10 This rule prohibiting an attorney from accepting representation adverse to a
11 former client is designed to not only prevent the dishonest practitioner from
12 fraudulent conduct, but also preclude the honest practitioner from putting themselves
13 in a position where they may be required to choose between conflicting duties, or be
14 lead to attempt to reconcile conflicting interest. *American Airlines Inc. v. Sheppard,*
15 *Mullin, Ruchter & Hampton*, 96 Cal.App.4th 1017, 1043 (2002). Furthermore, the
16 rule must be vigorously applied to protect the former client’s legitimate expectations
17 of loyalty and trust. *Adams v. Aerojet-General Corp.*, 86 Cal.App.4th 1324, 1340
18 (2001).

19 As argued above, Ms. Mankey and Ackerman LLP’s representation of
20 Defendants against their former client, Solorio, is not permitted under California
21 law. Defendants have signaled they intend to argue the trademark applications and
22 work done on behalf of Solorio was erroneous, which is materially adverse to
23 Solorio’s interest. Permitting this argument by Solorio’s former attorney will either
24 encourage fraudulent conduct, or at a minimum force Mankey and Ackerman LLP
25 to choose between their conflicting duties to Solorio and Defendants.

26 As a former client, Solorio has a legitimate expectation of loyalty and trust
27 for the work performed by his counsel regarding prosecuting his trademark. The
Court cannot condone Plaintiff Solorio’s former attorneys attempting to invalidate

1 the work performed on his behalf. Accordingly, they must be disqualified in this
2 case.

3 **VI. Continued Representation of Defendants, by Mankey and Ackerman Will**
4 **Violate California's Rules of Professional Conduct Rule 3.7, Prohibiting**
5 **Representation by a Lawyer Likely to be a Witness.**

6 In California lawyers are prohibited from acting as trial counsel in a matter
7 they are likely to be called a witness, unless the testimony relates to an uncontested
8 matter, the nature and value of services rendered in a case, or the lawyer has
9 obtained informed written consent. Cal. Rules Prof. Conduct, Rule 3.7. Further, the
10 Court retains discretion to disqualify likely advocate-witness as counsel, where
11 there is convincing demonstration of detriment to opponent or injury to the
12 integrity of the judicial process. *Lopez v. Lopez*, 81 Cal.App.5th 412, 423 (2022).
13 An attorney should resolve any doubt in favor of preserving the integrity of their
14 testimony and against participation as trial counsel whenever the attorney knows
15 they ought to be a material witness in the client's case. *People v. Rices*, 4 Cal.5th
16 49, 66 (2017).

17 This case is unique because Ms. Mankey not only requested that Solorio sign
18 the representation form for the trademark application for SHOE DOCTM that was
19 filed by Defendant Stromberg (which Ms. Mankey now contends is jointly owned
20 by Solorio and CareCo), but also submitted multiple declarations to the USPTO
21 stating she had personal knowledge of the dates of the SHOE DOCTM, stylized
22 DOCTM, and FZ 150TM trademarks were first used, and when they were first used
23 in interstate commerce. Given Defendants intends to dispute the dates in the
24 various submitted trademark applications, Ms. Mankey is a key witness to describe
25 the accuracy and basis of the content in the filed trademark declarations.

26 Moreover, permitting Solorio's former counsel to act as a witness to
27 contradict her prior statements to the USPTO and advocate against him will be

1 detrimental to Solorio. Solorio would clearly suffer harm if his former counsel
2 declared the legal work performed for him was erroneous and then were permitted
3 to argue on behalf of his adversary's position. This obvious conflict would also
4 damage the integrity of the legal process.

5 Given the fact Ms. Mankey is a necessary witness in this matter, and her
6 continued representation of Defendants will cause injury to Solorio, she must be
7 disqualified as counsel.

8 **VII. Conclusion**

9 Ms. Mankey and Ackerman LLP are attempting to represent multiple
10 defendants against their former client, Solorio. They have not been provided
11 informed written consent to do so, and the representation involves the very subject
12 matter they represented Solorio on—his prior trademark applications. Given there
13 is a substantial relationship between the prior legal work and this case, confidential
14 information is conclusively presumed to have been transmitted. Accordingly,
15 continued representation of Defendants against Solorio will violate the California
16 Rules of Professional Conduct.

17 Furthermore, Ms. Mankey is a key witness in this case given the content of
18 her declarations to the USPTO, and the fact Defendants now dispute the accuracy
19 of those declarations. California law is clear that it does not permit a lawyer to
20 serve as an advocate and witness in the same matter.

21 Given the above, disqualification of Ms. Mankey and Ackerman LLP in this
22 matter is required to avoid any further damage to Solorio, their former client.
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2 Respectfully submitted,

LAW OFFICE OF DREW PETERSEN, P.C.

3
4 Dated May 24, 2024

/s/ Gordon Andrew Petersen, II

5 Gordon Andrew Petersen, II
6 Attorney for Defendant,
7 Miguel Solorio

8 THE KINDER LAW GROUP, APC

9 Dated May 24, 2024

/s/ Brian Kinder

10 Brian Kinder
11 Attorney for Defendant,
12 Miguel Solorio